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In re Application of
Pedersen et al.
Application No.: 10/533,696
PCT No.: PCT/US03/36077
Int. Filing Date: 07 November 2003
Priority Date: 08 November 2002
Attorney Docket No.: 2005INO02
For: Adaptive Broadband Platforms
And Methods Of Operation

:
DECISION
ON
PETITION

This is in response to the petition under 37 CFR 1.47(a) filed on 25 September 2006.

BACKGROUND

This international application was filed on 07 November 2003, claimed an earliest priority date of 08 November 2002, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 09 May 2005 (since 08 May 2005 was a Sunday). Applicants filed *inter alia* the basic national fee on 03 May 2005.

On 21 June 2006, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the filing of an oath or declaration compliant with 37 CFR 1.497(a) and (b), \$2900.00 in additional claim fees, and a \$130.00 surcharge under 37 CFR 1.492(h).

DISCUSSION

With regard to the fees paid in this application, MPEP 607 provides in part that

A preliminary amendment filed concurrently with a response to a Notice To File Missing Parts of Application that required the fees set forth in 37 CFR 1.16, which preliminary amendment cancels or adds claims, will be taken into account in determining the appropriate fees due in response to the Notice To File Missing Parts of Application

The instant petition is accompanied by a "Preliminary Amendment" which results in 20 total claims and 5 independent claims remaining in the application. Therefore, following the practice described at MPEP 607, payment of \$200.00 for two extra independent claims at the small entity rate of \$100.00 per independent claim was required as part of the (revised) required response to the Notification of Missing Requirements. Petitioner has paid this fee, as well as the \$65.00 small entity surcharge under 37 CFR 1.492(h). However, it is noted that a two-month extension of time was required for the response to be considered timely; accordingly, \$225.00 of the fees paid are being allocated to this purpose. This results in a balance of \$95.00 prior to accounting for the petition fee. The proper fee for the petition under 37 CFR 1.47(a) is \$200. Therefore, petitioner owes the resulting \$105.00 balance of the petition fee.

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), the full petition has not been paid, as noted above. Therefore, requirement (1) has not been satisfied.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of joint inventor Erling Pedersen be excused, but does not specifically indicate whether Mr. Pedersen refused to sign the declaration or, alternatively, whether he cannot be found or reached after diligent effort. Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP § 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included >in the< statement of facts. It is important that the statement contain facts as opposed to conclusions.

...

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner states that

The Declaration signed by Roc A. Lastinger and a complete copy of the application including claims was sent to the last known address of Erling J. Pedersen... I sent the materials on August 8, 2006 via USPS Express Mail, certified with return receipt requested. The unopened Express Mail package was returned to me...

Further inspection of the materials accompanying the petition reveals that the USPS "Track & Confirm" sheet indicates that parcel EQ057152391US "was refused by the addressee at 8:46 am on August 17, 2006 in PHOENIX, AZ 85078 and is being returned to the sender." There is no clear indication in the application file that this was not the proper address for Mr. Pedersen. This suggests that it is not the case that he "cannot be found or reached after diligent effort" within the meaning of 37 CFR 1.47(a). As for the issue of whether the "refusal" of the parcel referenced on the "Track & Confirm" sheet evidences conduct which amounts to a refusal to execute the application, it is noted that the copy of the letter from petitioner to Mr. Pedersen refers to an "enclosed patent application" and requests that Mr. Pedersen "please carefully review and sign the Declaration enclosed." However, the letter does not specifically identify the patent application at issue (i.e., by application number). Therefore, it is not clear that an attempt was made to present Mr. Pedersen with a copy of this specific application and an oath or declaration directed to it. Therefore, it would not be appropriate to conclude that he has "refused" to execute the application within the meaning of 37 CFR 1.47(a) on the basis of the present record.

Regarding requirement (3), the petition provides the last known address of Erling Pedersen.

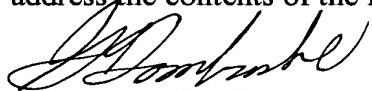
Regarding requirement (4), the declaration filed on 25 August 2006 is suitable for purposes of compliance with 37 CFR 1.47(a) and 1.497(a) and (b).

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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